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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/632,391	07/31/2003	Sammie J. Glorioso	APC-PT290.2US	2917

3624 7590 10/30/2006

VOLPE AND KOENIG, P.C.
UNITED PLAZA, SUITE 1600
30 SOUTH 17TH STREET
PHILADELPHIA, PA 19103

EXAMINER

YAO, SAMCHUAN CUA

ART UNIT	PAPER NUMBER
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1733

DATE MAILED: 10/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/632,391

Applicant(s)

GLORIOSO, SAMMIE J.

Examiner

Sam Chuan C. Yao

Art Unit

1733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 16-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>7-31-3 & 1-9-6</u> . | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1733

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-14, drawn to a process for manufacturing composite structural insulated panel, classified in class 156, subclass 79.
 - II. Claims 16-22, drawn to an apparatus for manufacturing composite structural insulated panel, classified in class 156, subclass 556.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the apparatus as claimed can be used to practice another and materially different process such as using an application system to apply non-foaming adhesive onto a board.
3. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Mr. Ryan O'Donnel on 10-24-06 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-15. Affirmation of this election must be made by applicant in replying to this

Art Unit: 1733

Office action. Claims 16-22 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-4, 6-9, and 13-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Larson (US 4,602,446).

With respect to claims 1-4, 6-9, 13 and 15, Larson discloses a continuous process for manufacturing foam building panels, the process comprising the following sequence of steps, sequentially placing 1st facing discrete boards such as plywoods or gypsum boards onto a conveying means using a conventional transfer mechanism; providing a pair of stiffening bars (taken to be the recited guide rails in claim 13) onto lateral side-ends portion of each of the 1st boards; depositing a catalyzed foamable composition such as a catalyzed foamable urethane onto each of the 1st boards; sequentially applying 2nd facing discrete boards such as plywoods or gypsum boards onto each of the foamable composition covered boards; heat curing the foamable composition in-between the two facing boards; and then cutting the cured board to a desired dimension (col. 1 lines 6-12; col. 2 lines 23-68; col. 4 lines 4-68; col. 5 lines 29-55; figures 1-2).

Art Unit: 1733

With respect to claim 14, while explicitly stated, the heat-cured board must inherently be cooled naturally in a section of conveying means through exposure to an ambient condition.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 5 and 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Larson (US 4,602,466) as applied to claim 1 or 9 above.

With respect to claims 5 and 10, the recited thickness is art recognized thickness for various conventional board materials. Additionally, one in the art would have determined a suitable board thickness for desired end characteristics of a finished foam building panel and would have determined a workable production rate. For these reasons, these claims would have been obvious in the art.

With respect to claim 11, the limitation in this claim would have been obvious in the art as such is an art recognized way of blending a catalyst to a foamable composition in order to prevent premature curing of the foamable material.

With respect to claim 12, a preference on whether to sequentially feed 1st boards onto a conveying means such that each of them are contiguous or equally spaced from each other is taken to be well within the purview of choice in the art.

None, but only the same desired result of forming foam building panels would

Art Unit: 1733

have been achieved. If it is desired to maintain the sequentially deposited 1st boards equally spaced from each other, a convenient and yet effective way to accomplish to provide spacers or buttresses on a conveyor belt. For this reason, this claim would have been obvious in the art.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Porter (US 2002/0136888 A1), Bengtson (US 3,915,773) and Savoy (US 5,194,323) are cited as references of interest showing foamed panels.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sam Chuan C. Yao whose telephone number is (571) 272-1224. The examiner can normally be reached on Monday-Friday with second Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Richard Crispino can be reached on (571) 272-1171. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1733

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Sam Chuan C. Yao
Primary Examiner
Art Unit 1733

Scy
10-24-06